

## REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on December 22, 2008, claims 1-24 are pending and stand rejected. Accordingly, Applicant respectfully provides the following:

### **Rejections under 35 U.S.C. § 103(a):**

Claims 1-16 and 18-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,295,064 ("Malec") in view of U.S. Patent No. 5,264,822 ("Vogelman") in further view of U.S. Patent No. 5,640,002 ("Ruppert") and claim 17 was rejected under 35 U.S.C. 103(a) as being unpatentable over Malec in view of Vogelmann in further view of Ruppert in further view of MacIntyer. Applicant respectfully notes that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to clearly articulate the reason(s) why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. See M.P.E.P. § 2142. As stated by the U.S. Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007), the analysis supporting a rejection made under 35 U.S.C. § 103 should be made explicit. Moreover, the Court reiterated in *KSR* that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* at 1396 (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)); M.P.E.P. §§ 2141.III- 2142.

In addition, the Court in *KSR* expressly instructs that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *Id.* at 1396; See M.P.E.P. 2143. "In determining the

differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02 (emphasis in original).

Moreover, while “the Supreme Court in *KSR* cautioned against an overly rigid application of TSM, it also recognized that TSM was one of a number of valid rationales ....” M.P.E.P. 2141.III. The Court also noted that the “establishment of the TSM approach to the question of obviousness ‘captured a helpful insight.’” *Id.* (Citing to *KSR*). Further, the Court stated that “there is no necessary inconsistency between the idea underlying the TSM test and the Graham analysis.” *Id.* (internal quotations omitted).

Finally, M.P.E.P. § 2142 sets forth the standard for avoiding impermissible hindsight as follows:

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at the time to that person. Knowledge of applicant’s disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the “differences,” conduct the search and evaluate the “subject matter as a whole” of the invention. The tendency to resort to “hindsight” based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

(Emphasis added). Applicants respectfully submit that the references cited in the Office Action, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein. Further, Applicants respectfully submit that the Examiner’s analysis offered in support of the Section 103 rejections has not been made explicit but rather relies on mere conclusory statements lacking both the necessary articulated reasoning and rational underpinning to support the legal conclusion of obviousness. Applicants also respectfully submit that there is

no suggestion or motivation to combine the references in the manner suggested by the Examiner, and that one of skill in the art would not reasonably expect success in combining the references in the manner provided. Likewise, Applicants respectfully submit that only by inappropriate hindsight would an artisan of ordinary skill combine the references in the allegedly obvious fashion advanced by the Examiner.

In particular, none of the prior art systems teach a simple apparatus, which allows for complex, up-to-date product specific information to be transmitted to a communication device on a shopping cart. Vogelmann teaches very simple broadcasting systems, which repeatedly broadcast audio messages into transmission zones and allows this simple broadcast to be received by consumers. This allowed Vogelmann's system to transmit audio advertising messages to shopping carts, while maintaining a simple apparatus on the shopping cart. By comparison, Malec teaches the use of a more complex apparatus on the shopping cart. Malec teaches a system that utilizes a complex cart mounted system containing a plethora of advertising messages and coupons, wherein the entire process for presenting consumers with media/information resides with the cart, and is merely triggered by trigger transmission as a cart moves through a shopping environment.

There is no suggestion in the art supporting the proposition that one skilled in the art would have been motivated to modify Malec's device capable of presenting consumers with complex media/information, as a cart moves through a shopping environment, with elements from Vogelmann's disclosure related to the simple repeated transmission of audio messages into transmission zones. In fact, Malec's disclosure contravenes the presumption that it would have been obvious to modify Malec's teachings by referencing Vogelmann. Malec expressly indicated that prior art systems utilized for in-store displays, while effective at influencing customers, had

the general downfall of being physically fixed to a point of purchase within the store and utilized primarily to promote a single product or group of products and needed to be changed from time to time by store personnel. Malec, Column 1, lines 31-38. Malec's objective was to produce a sophisticated onboard shopping cart display system, "including a cart mounted display responsive to unique trigger signals provided by respective transmitters associated with respective fixed locations." In particular, Malec disclosed the use of an on-board computing system to facilitate display of a plethora of visual messages, print coupons and scents to be dispersed at appropriate locations upon receipt of the appropriate signal from a trigger transmitter. Malec directly indicates that his invention overcame the disadvantages of simply the prior art systems by providing customers with dynamically changing advertisements and information to influence the consumer. Malec, Column 1, lines 53-57. Malec's solution then to the deficiencies of the prior art advertising systems was to provide a shopping cart with an onboard unit capable of providing flexible information stored at the cart. Accordingly, one of ordinary skill in the art, utilizing Malec as a primary source of information, would not have been motivated to alter Malec's advanced system for providing dynamic and changing advertisements to shopping cart display systems with information from Vogelman, which teaches a simple system for providing audio advertising messages to shopping carts moving through spatially defined transmissions zones arranged in the store.

Vogelman also teaches away from the combination of Malec and Vogelman, indicating that video-based systems utilize unnecessarily "complex equipment intensive and prone to failure, requiring high levels of maintenance. Furthermore, these systems require the shopper to continually look at the cart display while walking through the store aisles." Vogelman, Column 1, lines 63-68. Accordingly, one skilled in the art would not be motivated to combine

Vogelman's teachings related to a simple audio transmission in view of Vogelmann's open teaching away from complex video systems with Malec's complex onboard video-based shopping cart apparatus. Vogelmann's system by contrast is simple system for broadcasting audio messages to shopping carts moving through a plurality of pre-defined spatial zones in a store, and incapable of transmitting complex, timely product specific information to individual shopping carts as they traverse a shopping environment.

Under an appropriate Section 103 analysis, it is clear that at the time of the invention, with no knowledge of the present invention, an artisan of ordinary skill would not have combined Malec and Vogelmann in the manner suggested by the Office Action. Only by using the roadmap of the present invention would an artisan of ordinary skill combine these two references in such a manner. Applicants respectfully submit that the Examiner used the present invention as a roadmap to inappropriately combine the above-mentioned references. Under an appropriate Section 103 analysis, it is clear that at the time of the invention, with no knowledge of the present invention, an artisan of ordinary skill would not have combined Malec and Vogelmann in the claimed manner.


For at least these reasons, Applicant respectfully submits that claim 1 is not made obvious by the cited combination of references and therefore respectfully request removal of the rejection. Claims 2-23 depend from claim 1 and are allowable for at least the same reasons. Applicants therefore respectfully request removal of all remaining rejections.

### CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 22 day of April, 2009.

Respectfully submitted,



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